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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,745	02/02/2001	Christopher S. Moore	10519/16	9392
7590	03/24/2005		EXAMINER	
BRINKS HOFER GILSON & LIONE SUITE 3600 455 N. CITYFRONT PLAZA DR. CHICAGO, IL 60611				HENEGHAN, MATTHEW E
		ART UNIT		PAPER NUMBER
		2134		

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/775,745	MOORE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Matthew Heneghan	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 27 December 2004.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-51 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-51 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 17 May 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____ .  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4 /IDS's</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____ .                                  |

**DETAILED ACTION**

1. In response to a restriction required, Applicant has elected claims 1-51. Claims 1-51 have been examined.

***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because it has not been signed by Inventor Daniel T. Brown.

***Information Disclosure Statement***

3. The following Information Disclosure Statements in the instant application have been fully considered:

IDS filed 30 July 2001.

IDS filed 12 February 2002.

IDS filed 4 March 2003.

IDS filed 11 August 2003.

***Specification***

4. The use of the trademark Java® has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 9, 27, and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Each claim contains the trademark/trade name Java®. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the

present case, the trademark/trade name is used to identify/describe a hardware-independent programming language and, accordingly, the identification/description is indefinite.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-6, 8, 10, 12, 17, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,223,190 to Aihara et al.

As per claims 1-4, a flash disk is used as a removable medium to transfer generated HTML program code from a device to a computer (see column 5, lines 55-57 and column 9, lines 27-39).

As per claim 5, 6, the HTML program generates references to accompanying images which are retrieved by using the HTML program (see column 7, lines 22-25).

As per claim 8, HTML is a hardware-independent language.

As per claim 10, the HTML program and the accompanying images are stored in different files, thus constituting partitions.

As per claim 12, Aihara discloses an image viewer.

As per claim 17, a flash disk addresses memory as a disk by cylinder, head, and sector; thus, it is a three-dimensional array.

As per claim 18, a flash disk is composed of semiconductor memory cells.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7, 11, 15, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,223,190 to Aihara et al. as applied to claims 6, 10, and 17 above, and further in view of U.S. Patent No. 6,766,417 to Tanaka et al.

Aihara does not disclose the layout of the memory with respect to persistent data storage.

Tanaka the writing of application data stored in a buffer being written to a flash ROM that is organized by pages, which do not change during normal operation; the area is therefore fixed (see column 5, lines 19-23 and column 6, lines 15-18) and only available on the solid-state memory device, and notes that when a read write control program for the information processing unit is developed for a flash ROM (write-once memory cells) of a specific capacity, a flash ROM of some other capacity becomes unable to be utilized by the program (see column 1, lines 40-44).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Aihara by writing application data to pages of a flash ROM, as disclosed by Tanaka, because when a read write control program for the information processing unit is developed for a flash ROM of a specific capacity, a flash ROM of some other capacity becomes unable to be utilized by the program.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,223,190 to Aihara et al. as applied to claim 8 above, and further in view of U.S. Patent No. 6,481,632 to Wentker et al.

Aihara only discloses the use of HTML with the smartcard.

Wentker discloses the use of Java, and suggests that this is a suitable Smartcard operating system (see column 6, lines 44-46).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to further modify the invention of Aihara by using Java applications, as disclosed by Wentker, as this is a suitable Smartcard operating system.

9. Claims 16, 20-26, 30, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,223,190 to Aihara et al. as applied to claim 6 above, and further in view of U.S. Patent No. 4,757,534 to Matyas et al.

Aihara does not disclose the encryption of programs on the smartcard.

Matyas discloses a system wherein the encryption key of a stored program may be based upon the identification of the smartcard (see column 8, line 31 to column 9, line 3), and notes that this provides for a program to be used only by the user of the smart card, discouraging copying (see abstract and column 1, lines 5-10).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Aihara by using encrypting programs according to a smartcard ID, as disclosed by Matyas, as this provides for a program to be used only by the user of the smart card, discouraging copying.

10. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,223,190 to Aihara et al. as applied to claim 6 above, and further in view of U.S. Patent Application Publication No. 2002/0161709 to Floyd et al.

Aihara does not disclose the encryption of programs on the smartcard.

Floyd discloses a content delivery system wherein product use can be either for a time period or a number of uses (see paragraph 22) and suggests that this reduces piracy by not making it fully useful to a customer until it is "purchased."

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Aihara by allowing product use for either a time period or a number of uses, as disclosed by Floyd, as this reduces piracy by not making it fully useful to a customer until it is "purchased."

11. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,223,190 to Aihara et al. in view of U.S. Patent No. 4,757,534 to Matyas et al. as applied to claim 26 above, and further in view of U.S. Patent No. 6,481,632 to Wentker et al.

Aihara and Matyas only disclose the use of HTML with the smartcard.

Wentker discloses the use of Java, and suggests that this is a suitable Smartcard operating system (see column 6, lines 44-46).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to further modify the invention of Aihara and Matyas by using Java applications, as disclosed by Wentker, as this is a suitable Smartcard operating system.

12. Claims 28, 29, 33, 36-41, 43-45, and 48-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,223,190 to Aihara et al. in view of U.S. Patent No. 4,757,534 to Matyas et al. as applied to claims 20 and 23 above, and further in view of U.S. Patent No. 6,766,417 to Tanaka et al.

Aihara and Matyas do not disclose the layout of the memory with respect to persistent data storage.

Tanaka the writing of application data stored in a buffer being written to a flash ROM that is organized by pages, which do not change during normal operation; the area is therefore fixed (see column 5, lines 19-23 and column 6, lines 15-18) and only available on the solid-state memory device, and notes that when a read write control program for the information processing unit is developed for a flash ROM (write-once memory cells) of a specific capacity, a flash ROM of some other capacity becomes unable to be utilized by the program (see column 1, lines 40-44).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Aihara and Matyas by writing application data to pages of a flash ROM, as disclosed by Tanaka, because when a read write control program for the information processing unit is developed for a flash ROM of a specific capacity, a flash ROM of some other capacity becomes unable to be utilized by the program.

13. Claims 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,223,190 to Aihara et al. in view of U.S. Patent No. 4,757,534 to Matyas et al. as applied to claims 20 and 23 above, and further in view of U.S. Patent Application Publication No. 2002/0161709 to Floyd et al.

Aihara and Matyas do not disclose the encryption of programs on the smartcard.

Floyd discloses a content delivery system wherein product use can be either for a time period or a number of uses (see paragraph 22) and suggests that this reduces piracy by not making it fully useful to a customer until it is “purchased.”

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Aihara and Matyas by allowing product use for either a time period or a number of uses, as disclosed by Floyd, as this reduces piracy by not making it fully useful to a customer until it is “purchased.”

14. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,223,190 to Aihara et al. in view of U.S. Patent No. 4,757,534 to Matyas et al. in view of U.S. Patent No. 6,766,417 to Tanaka et al. as applied to claim 41 above, and further in view of U.S. Patent No. 6,481,632 to Wentker et al.

Regarding claim 42, Aihara, Matyas, and Tanaka only disclose the use of HTML with the smartcard.

Wentker discloses the use of Java, and suggests that this is a suitable Smartcard operating system (see column 6, lines 44-46).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to further modify the invention of Aihara, Matyas, and Tanaka by using Java applications, as disclosed by Wentker, as this is a suitable Smartcard operating system.

15. Claims 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,223,190 to Aihara et al. in view of U.S. Patent No. 4,757,534 to Matyas et al. in view of U.S. Patent No. 6,766,417 to Tanaka et al. as applied to claims 37 and 39 above, and further in view of U.S. Patent Application Publication No. 2002/0161709 to Floyd et al.

Aihara, Matyas, and Tanaka do not disclose the encryption of programs on the smartcard.

Floyd discloses a content delivery system wherein product use can be either for a time period or a number of uses (see paragraph 22) and suggests that this reduces piracy by not making it fully useful to a customer until it is "purchased."

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Aihara, Matyas, and Tanaka by allowing product use for either a time period or a number of uses, as disclosed by Floyd, as this reduces piracy by not making it fully useful to a customer until it is "purchased."

### ***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday, Tuesday, Thursday, and Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse, can be reached at (571) 272-3838.

**Any response to this action should be mailed to:**

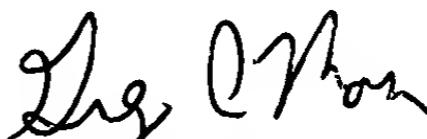
Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**

(703) 872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
GREGORY MORSE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

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March 18, 2005